

REMARKS

Status of the claims

Claims 57, 68-71, 87-91, 93 and 96-102 are pending. Claims 91, 93, and 96-102 have been withdrawn from consideration, but as they contain all of the limitations of the elected composition claims, they are eligible for rejoinder upon allowance of the claims under consideration.

Rejections Withdrawn

The obvious-type double patenting rejections and rejections under 35 U.S.C. §§ 102/103 have been withdrawn.

Claim Objections

Claims 57 and 68-71 were objected to on the grounds that claim 57 used in the incorrect terminology “zinc finger domain” when referring to a “zinc finger protein.” (Office Action, page 12).

The Examiner’s recitation of the claim language is incorrect. Claim 57 was amended to recite a zinc finger protein in an amendment filed February 26, 2008. The recitation that the claimed zinc finger protein comprises 3 or more zinc finger domains was added in the paper filed September 10, 2008 and this amendment did not change the term “zinc finger protein” to “zinc finger domain.” Indeed, the claim amendments simply clarified that the claimed zinc finger protein is made up for 3 or more zinc finger domains. Thus, the objection is improper and should be withdrawn.

35 U.S.C. § 112, 2nd paragraph

Claims 57 and 68-71 were also rejected under 35 U.S.C. § 112, 2nd paragraph as allegedly unclear whether the non-naturally occurring recognition helix refers to the protein or the nucleic acid recognized by the protein. (Office Action, page 13).

Applicants traverse the rejection. As would be clear to the skilled artisan, the claim is unambiguous that the “recognition helix” refers to the helix of the zinc finger domain that is formed from amino acids. See, e.g., paragraphs [0111] and [0114] and

accompanying Tables. The Examiner appears to be confusing an amino acid recognition helix with the double helix structure of double-stranded DNA. However, the Examiner's confusion would not be shared by the skilled artisan. Thus, the claims are completely clear and the rejection should be withdrawn.

35 U.S.C. § 112, 1st paragraph, written description (new matter)

Claims 57 and 68-71 were also rejected under 35 U.S.C. § 112, 1st paragraph as allegedly containing new matter not described in the originally filed specification, namely a zinc finger protein comprising at least one zinc finger domain with a non-naturally occurring recognition helix. (Office Action, pages 13-14).

Although Applicants submit that the as-filed specification clearly evinces possession of multi-fingered zinc finger proteins having one or more non-naturally occurring recognition helices, the claims have been amended as shown above to specify that all the zinc finger domains of the recited proteins are non-naturally occurring. Literal support is found throughout the as-filed specification, for example in paragraphs [0111] and [0114] and the accompanying Tables. Thus, the rejection has been obviated and should be withdrawn.

35 U.S.C. § 103

Claims 57 and 68-71 were also rejected under 35 U.S.C. § 103 as allegedly obvious over U.S. Patent Nos. 7,235,354; 7,177,766; 7,045,304; 6,989,269; 6,785,613; 6,780,590; 6,777,185; 6,599,692; 6,453,242; 7,220,719; 7,163,824; 7,013,219; 6,979,539; 6,933,113; 6,824,978; 6,689,558; 6,607,882; and 6,534,261. (Office Action, pages 14-15).

The instant application and all of the cited references are owned by Sangamo BioSciences. Thus, pursuant to 35 U.S.C. § 103(c), the cited patents are disqualified as prior art since the claimed subject matter and the subject matter of the cited patents were, at the time the inventions were made, owned by the same person or subject to an obligation of assignment to the same person. See, also, M.P.E.P. § 706.02(I)(1). Accordingly, the rejections must be withdrawn.

CONCLUSION

For the reasons set forth herein, allowance of the claims under consideration, and rejoinder and allowance of the withdrawn claims, are requested.

Respectfully submitted,

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